

REMARKS

Pursuant to the present amendment, claims 21-24 and 30-34 have been amended. Claims 21-24 and 30-34 are pending in the present application. No new matter has been introduced by way of the present amendment.

In the Office Action, the Examiner issued several objections to claims 21-24 and 30-34. Pursuant to the present amendment, the pending claims have been amended in a manner that is believed to render the Examiner's objections moot. Withdrawal of the objections to the claims is respectfully requested.

In the Office Action, claims 21 and 30-32 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Rose (U.S. Patent No. 3,102,356) or, in the alternative, under 35 U.S.C. § 103 as allegedly being unpatentable over Rose in view of Subba Rao (U.S. Patent Publication No. 2001/0051831) or Fuchs (DE 20022306). Claims 22-24 and 33-34 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Rose, Subba Rao and Fuchs. Applicants respectfully traverse the Examiner's rejections.

Pursuant to the present amendment, independent claim 21 has been amended to recite, among other things, a first neck having an externally threaded portion and an internal tapered, cylindrical-shaped bore, wherein the externally threaded portion of the first neck is adapted to be threadably engaged with the threaded bore of the body of the femoral head, and a femoral hip stem, the femoral hip stem comprising a second neck having a tapered outer surface that is adapted to be positioned in the tapered, cylindrical-shaped internal bore in the first neck to thereby form a Morse taper connection. Support for these amendments can be found in the specification at, for example, page 6, line 10 – page 8, line 16, and the associated drawings.

Pursuant to the present amendment, independent claim 30 has been amended to recite, among other things, an assembly including a femoral head having a body with an outer surface

adapted to articulate with an acetabular component, the femoral head comprising an internally threaded bore, a first neck having a first externally threaded end adapted to be threadingly connected to the internal threaded bore of the femoral head and a second end comprising a tapered, cylindrical-shaped internal bore, and a femoral hip stem comprising a second neck having a tapered outer surface that is adapted to be positioned in the tapered, cylindrical-shaped internal bore in the first neck to thereby form a Morse taper connection. Support for these amendments can be found in the specification at, for example, page 6, line 10 – page 8, line 16, and the associated drawings.

As thus amended, it is respectfully submitted that all pending claims are readily distinguishable from Rose. Rose does not disclose or suggest the structure now recited in the pending claims. For example, Rose does not disclose an assembly comprising the recited first and second necks, nor does it disclose or suggest the detailed structure now recited in the pending claims for connecting the second neck and the first neck to one another. Accordingly, it is respectfully submitted that the rejections based upon Rose should be withdrawn.

The citation to Subba Rao cannot cure the fundamental deficiencies in Rose – the Examiner's primary reference. Subba Rao is believed to be clearly different from the inventions set forth the pending claims. In Subba Rao, the neck 40 does not have a threaded portion. Nor is the neck 40 threadingly engageable with a threaded bore in the femoral head. As understood by the undersigned, the neck 40 in Subba Rao is designed to slidably move within the coupling member 26. A spring element 32 is employed to purportedly absorb shock and vibration encountered in daily life. ¶¶35-37.

As thus understood, it is respectfully submitted that Subba Rao does not anticipate nor render obvious the pending claims. In Subba Rao, the neck is not adapted to be threadingly coupled to the bore in the femoral head. The neck 40 is designed to effectively "float" within the

coupling member 26. Moreover, the “spacer” (coupling member 26) identified by the Examiner is not adapted to engage a bottom surface of the bore or an end surface of the neck when the neck is threadingly coupled to the bore and the neck is seated therein. In Subba Rao, it does not appear that any surface of the coupling ever engages the end surface of the neck 40 or the bottom surface of the bore. In Figure 4B, the screw 46 prevents the coupling from engaging the bottom surface of the bore.

Moreover, it is respectfully submitted that any attempt to assert that the pending claims would have been obvious in view of the prior art would be improper. First, even if Rose and Subba Rao were combined, that combination of art would still not teach all of the claimed limitations. Thus, such a rejection would be legally improper. Moreover, there is simply no suggestion in the art of record to modify the teachings of Rose and Subba Rao to arrive at Applicants’ claimed invention. In fact, Subba Rao goes to great lengths to provide relative movement between the neck 40 and the femoral head 24. All pending claims require that the first neck is adapted to be threadably engaged with the threaded internal bore in the femoral head. Thus, modification of Subba Rao such that the neck 40 therein would be threadingly coupled to the head 24 would be contrary to the express teachings of Subba Rao.

The citation to Fuchs does not overcome the fundamental deficiencies in Rose as it relates to the structure recited in the amended claims. Accordingly, any obvious rejection based upon the combination of Rose and Fuchs is, respectfully, without merit.

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. It is

respectfully submitted that any attempt to assert that the invention defined by the amended claims submitted herein would have been obvious in view of the prior art of record constitutes an impermissible use of hindsight using Applicants' disclosure as a roadmap.

In summary, it is believed that amended claims 21-24 and 30-34 are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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Date: April 4, 2006

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